

REMARKS

Claims 11 to 19 remain in the case.

In the Office Action, the Examiner has again rejected Claims 11 to 15 as allegedly being unpatentable over the prior art. In so doing, the Examiner has reiterated his previous comments as far as the teachings of the prior art.

Claim 11 is directed to a method for the use of quarry fines. As the Examiner has pointed out, Kruidhof discloses a method for reducing the phosphor content of liquid manure. No where in the prior art is there a disclosure for the method recited by Claim 11 and there is nothing within the four corners of the reference that would lead one to such a method. Quarry fines are normally a waste product with very little economic use. Applicant has succeeded in finding a use for such quarry fines and Claim 11 is directed to such a use.

The other prior art cited and applied against the claims again do not begin to teach the method of the present invention.

It is noted that the Examiner has stated that Wehling et al teaches that it is known to obtain magnesium oxide from a quarry. Specifically, this reference only teaches that low reactivity magnesium oxides are commercially available products. This reference does not add anything to the lack of teachings of the primary reference of the method. Applicant does not see any teaching of the use of a normally low value product in a specific process.

There is nothing in the cited art to suggest what Applicant did. In fact, these references do not even contain any suggestion that they could be combined in the manner proposed by the Examiner. However, this is a prerequisite for a combination rejection, as stated by the Patent Office Board of Appeals in its decision in *Ex parte Walker*, 135 USPQ 195:

"In order to justify combination of references it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so."

The Court of Customs and Patent Appeals subscribed to the Board's reasoning, when it handed down its decision in the case *In re Imperato*, 179 USPQ 730, holding:

"The fact that the disclosures of references can be combined does not make combination obvious unless the art also contains something to suggest the desirability of such a combination."

With regard to the principal rejection, we agree that combining the teaching of Schaefer with that of Johnson or Amberg would give the beneficial result observed by appellant. However, the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. In re Bergel, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206 (1961). We find no such suggestion in these references."

In fact the art must not only be combinable in accordance with the principles of the above decisions, but to support a valid combination rejection the art must also suggest that the combination would accomplish Applicant's results. This was stated by the Patent Office Board of Appeals in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

"Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish Applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices."

It is also well settled that an inventive combination cannot be anticipated by finding individual features separately in the prior art and combining them in a piecemeal manner to show obviousness. Note would be taken in this connection of the decision of the Court of Customs and Patent Appeals *In re Kamm and Young*, 17 USPQ 298 ff, which appears most pertinent to the issues at hand and wherein the claims were also rejected over a combination of references. The Court held that:

"The rejection here runs afoul of a basic mandate inherent in section 103 - that 'a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). 'It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.' In re Wesslau, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965)."
Emphasis added.

The mere fact that an invention is simple and accomplishes only a small but genuine improvement is not sufficient reason to deny it patent protection.

In Schnell et al v. The Allbright-Nell Co. et al, 146 USPQ 322, the U.S. Court of Customs and Patent Appeals held that:

"Device seems simple and obvious in light of patentee's teaching, but it evidently was not obvious at time of invention; those working in the field did not accomplish patentee's results; that fact supports conclusion that patentee achieved patentable invention."

In view of the above, it is respectfully submitted that Claim 11 and claims dependent therefrom are clearly allowable over the prior art and such action is respectfully solicited.


Respectfully,



Eric Fincham

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the Commissioner for Patents, Alexandria, VA 22313-1450 at Fax No. (571) 273-8300 on the date set forth below.


Eric Fincham, Reg. 28,201

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Date